ATTENTION: BOX AFTER FINAL
EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 1617

PATENT
Customer No. 22,852
Attorney Docket No. 5725.0446-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#26
N.E.
AKO
2-3-03

In re Application of:	)	
	)	
Serge RESTLE et al.	)	Group Art Unit: 1617
	)	
Application No.: 09/360,521	)	Examiner: L. Wells
	)	
Filed: July 23, 1999	)	
	)	
For: AMINATED SILICONE DETERGENT COSMETIC COMPOSITION AND USE	)	

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE AFTER FINAL REJECTION

In response to the Office Action of July 30, 2002, the period for response having been extended three months to January 30, 2002, by the accompanying Petition and fee, reconsideration of this application is requested in view of the remarks presented herein. Claims 1-46 are pending; no claim is amended by this paper.

Applicants thank the Examiner for withdrawing the rejections under 35 U.S.C. § 102 over each of U.S. Patent No. 6,028,041 to Decoster *et al.* and U.S. Patent No. 6,159,914 to Decoster *et al.*, and under 35 U.S.C. § 103 over the combination of U.S. Patent No. 4,185,087 to Morlino in view of U.S. Patent No. 6,162,423 to Sebag and U.S. Patent No. 5,476,649 to Natio. Applicants also thank the Examiner for her time

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conducting an in-person interview on November 12, 2002, discussing some of the outstanding issues.

Rejection Under the Doctrine of Obviousness-Type Double Patenting:

Claims 1-46 stand rejected under the doctrine of obviousness-type double patenting over the claims of U.S. Patent Nos. 6,028,041, 6,159,914, 6,162,424, and 6,290,944[1], and copending Application No. 09/759,165. (Office Action, pg. 2.) Applicants respectfully disagree with and traverse the rejection.

The Office acknowledges that the referenced patents and application "do no[t] teach the specific [amphoteric/anionic surfactant] ratio" of the presently claimed invention. (Office Action, pg. 2, In. 18-19.) Nevertheless, the Office argues that "the claims of these patents and application encompass any and all ratios... [and, thus, the instant claims are not distinguished because] it is within the skill of one in the art to discover the optimum range... ." (Office Action, pg. 2, In. 19-20.) However, this conclusion is legally flawed.

1. *THE OFFICE HAS IMPROPERLY RELIED UPON A CLAIM DOMINATION THEORY TO SUPPORT THE PRESENT REJECTION*

By arguing that "the claims of these patents and application encompass any and all ratios," the Office appears to associate claim domination with obviousness. This is improper. "Domination by itself... cannot support a double patenting rejection." M.P.E.P. § 804 (emphasis added).

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[1] U.S. Patent No. 6,290,944 was cited in the Office Action dated March 13, 2002, at page 2, but, without comment, the patent was not cited in the Office Action dated July 30, 2002. For the sake of completeness, Applicants will, nevertheless, address the rejection including this patent. Clarification of the status of this rejection is requested.

Additionally, Applicants point out that the

> analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination... [and] the factual inquiries set forth in *Graham v. John Deere Co*... are employed when making an obvious-type double patenting analysis.

M.P.E.P. § 804. However, in making the present double patenting rejections, the Office has not even attempted to present evidence of all the basic elements required to establish a prima facie case of obviousness, such as a motivation to modify each given reference.

Therefore, since the Office has improperly relied upon a claim domination theory without asserting any evidence in support of this rejection and has also not established *all* the elements of a prima facie case of obviousness, the rejection is legally erroneous and should be withdrawn.

2. *THE OFFICE HAS FAILED TO ESTABLISH THAT AN AMPHOTERIC/ANIONIC SURFACTANT RATIO WAS RECOGNIZED AS A RESULT EFFECTIVE VARIABLE, AND CANNOT RELY ON ITS ALLEGED "ROUTINE OPTIMIZATION."*

The Office argues with respect to the amphoteric/anionic surfactant ratio that "it is within the skill of one in the art to discover the optimum range... ." (Office Action, pg. 2, ln. 19-20.) However, the Office's argument is in direct conflict with the guidelines established in the MPEP and in the relevant case law. The Office's alleged "routine optimization" theory is wrong as a matter of law.

According to the MPEP,

> [a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation."

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MPEP § 2144.05 (emphasis added). See also *Ex parte Samain and Dupuis* ("Samain"), Appeal No. 2001-1993 at 5, 7 (Bd.Pat.App.Inter. July 31, 2002) (courtesy copy provided to the Examiner by facsimile on October 11, 2002), wherein the Board overturned the examiner's argument that "relies upon optimization by one of ordinary skill in the art to arrive at the claimed Tg and wetting power," for the reason that

> the examiner has not provided the requisite reason, suggestion or motivation... such as by establishing that the claimed Tg and wetting power are result effective variables. The examiner has also failed to establish that the claimed Tg and wetting power were known to be, in fact, inherent characteristics of the composition of [the cited reference].

During the November 12, 2002, Examiner's Interview, it appeared to be the Office's position that the claims of the referenced patents and applications had both amphoteric and anionic surfactants, and therefore that they inherently and necessarily disclosed an amphoteric/anionic surfactant ratio. Even assuming this is true, this is insufficient to establish that the ratio was recognized as result effective. Thus, even assuming that the cited references inherently disclose some amphoteric/anionic surfactant ratio, this fails to render the Office's alleged "optimization" obvious.

For instance, from the decision in *Samain*, *supra*, it can be inferred that the products of the cited reference inherently had some specific (but unknown) Tg and wetting power. However, as stated by the Board, missing from the examiner's argument was evidence that these parameters were recognized as result effective variables or that the claimed values were inherent. *Samain* at 5, 7. Absent such recognition, and thus any motivation to optimize these variables, the examiner's rejection was reversed. *Id.*

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Likewise, in the present case, the question remains: where is the motivation to optimize an amphoteric/anionic surfactant ratio when there is no recognition that this ratio is a result effective variable? The Office's only answer, that "it is within the skill of one in the art to discover the optimum range," is plainly insufficient to establish the requisite motivation in light of the Board's decision in *Samain*.

Analogous to the facts of *Samain*, the Office has not established that the claimed amphoteric/anionic surfactant ratio was recognized as a result effective variable or that the claimed values were inherent.[2] Absent such recognition, there would have been no motivation for the Office's proposed optimization, and thus, the Office cannot establish and, in fact, has not established, a prima facie case of obviousness.

Since there is no evidence of record showing that an amphoteric/anionic surfactant ratio was recognized as a result effective variable in the claims of U.S. Patent Nos. 6,028,041, 6,159,914, 6,162,424, and 6,290,944, and copending Application No. 09/795,165, the Office errs in concluding that it would have been obvious to optimize the surfactant ratios in light of the claims therein, and further in maintaining the present obviousness-type double patenting rejections. Accordingly, reconsideration and withdrawal of the double patenting rejections are respectfully requested.

Should the Office maintain any of the present obviousness type double patenting rejections, in order to clarify the record for Appeal the Office is requested to expressly state its position with respect to the alleged optimization of the amphoteric/anionic surfactant ratio. Specifically, the Office is requested to:

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[2] It is important to distinguish between some ratio being inherent, and the claimed ratio being inherent in the cited references. As discussed above, the former is insufficient to establish a prima facie case of obviousness.

(1) identify any alleged evidence in the claims of the referenced patents and application that shows the ratio to have been recognized as a result-effective variable, or

(2) concede the there is no such evidence.

Rejection Under 35 U.S.C. § 112, Second Paragraph:

Claim 34 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for the asserted reason that the phrase "quaternary derivatives of cellulose ether" is vague and indefinite. (Office Action, pg. 3, ln. 3-4.) Applicants respectfully disagree with and traverse the rejection for the reasons of record.

Nevertheless, the Examiner has indicated that this rejection can be overcome if Applicants state on the record that the meaning of "quaternary derivatives of cellulose ether" recited in claim 34 is that defined by U.S. Patent No. 4,240,450 to Grollier et al., col. 4, ln. 20 to col. 5, ln. 23, cited in Applicants' Amendment dated June 13, 2002. (Office Action, pg. 3, ln. 8-10.) Accordingly, Applicants state for the record that the meaning of "quaternary derivatives of cellulose ether" recited in claim 34 is that as defined by U.S. Patent No. 4,240,450 to Grollier et al., col. 4, ln. 20 to col. 5, ln. 23.

Reconsideration and withdrawal of the rejection are respectfully requested.

Rejections Under 35 U.S.C. § 103(a):

I. WO 98/03155 in view of U.S. Patent No. 5,567,428 to Hughes in further view of U.S. Patent No. 5,476,649 to Natio

Claims 1-46 stand rejected over WO 98/03155 (Sebag) in view of U.S. Patent No. 5,567,428 (Hughes) in further view of U.S. Patent No. 5,476,649 (Natio). Applicants respectfully disagree with and traverse the rejection, which is deficient for at least the

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following reasons.[3] Reconsideration and withdrawal of the rejection are respectfully requested.

1. *BEING ALLEGEDLY "WITHIN THE SKILL OF ONE IN THE ART" IS NOT SUFFICIENT EVIDENCE OF A MOTIVATION FOR A PROPOSED SUBSTITUTION*

The present rejection is premised on substituting silicones according to Sebag with alkylamino substituted silicones according to Hughes. The Office argues, as alleged motivation for the substitution, that "substituting one for the other for hair conditioning purposes, would be within the skill of one in the art." (Office Action, pg. 5, ln. 15-16; pg. 8, ln. 9-10 (emphasis added).) However, even if such a substitution would have been within the skill of one in the art, the Federal Circuit has repeatedly and clearly held that similar conclusory statements are insufficient to established a prima facie case of obviousness. Instead, a rejection must be supported by a specific motivation of record. *In re Rouffet*, 37 USPQ2d 1453,1459 (Fed. Cir. 1998) (high level of skill in art, without more, cannot supply required motivation to combine references, and does not overcome absence of any actual suggestion to combine); *see also In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002).

Accordingly, since the present rejection relies on this legally erroneous substitution theory, without any supporting evidence of record, the rejection is in error and should be withdrawn.

2. *THE OFFICE HAS NOT SHOWN THAT AN AMPHOTERIC/ANIONIC SURFACTANT RATIO OR AN AMINE NUMBER WERE RECOGNIZED AS*

[3] Although for the sake of clarity the cited references are, in some instances, discussed one at a time, it should be understood that all of Applicants' discussions with respect to the rejections under section 103 are to the cited reference combinations taken as a whole.

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RESULT EFFECTIVE, AND THEREFORE CANNOT RELY ON THE PRINCIPLE OF "ROUTINE OPTIMIZATION."

The rejection is based on an alleged "routine optimization" of an amphoteric/anionic surfactant ratio and amine number. *See, e.g.*, Office Action, pg. 5, ln. 20 to pg. 6, ln. 2 ("It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach [sic] the amphoteric/anionic ratio of Sebag as greater than or equal to 0.2:1, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovery optimum or workable ranges involves only routine skill in the art."). The rejection is in error. It is based on an incorrect legal standard for optimizing a variable.

As discussed in detail above, before optimization can be routine, a variable must first be recognized in the art as result effective. *See, e.g.*, MPEP §2144.05; *see also Samain, supra*. However, the Office has not even attempted to provide evidence that an amphoteric/anionic surfactant ratio or amine number were recognized as result-effective variables. It is therefore legally erroneous to consider the "optimization" of such variables to be routine.

Accordingly, since the present rejection relies on an unsupported and legally erroneous "routine optimization" theory, the rejection is in error and should be withdrawn.

3. *THERE IS NO MOTIVATION FOR PICKING AMODIMETHICONE FROM AMONG HUGHES'S NUMEROUS SILICONE-BASED DRYING AIDS*

As noted above, the present rejection is premised on substituting silicones according to Sebag with alkylamino silicones, specifically an amodimethicone,

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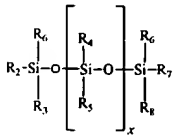
according to Hughes. However, there is no motivation for the Office's arbitrary selection of an amodimethicone having an amine number of greater than or equal to 0.4 meq/g.

Hughes discloses a variety of drying aids at col. 12, ln. 32 - col. 15, ln. 2, but provides little guidance for selecting any particular drying aid. Among Hughes' expressly identified drying aids are polysiloxanes of the formula  (Hughes, col. 12, lns. 23-32), but there is no teaching, suggestion or motivation to direct one skilled in the art from this general formula to an aminosilicone within the scope of the presently claimed invention. Hughes also mentions alkylamino substituted silicones (amodimethicone) (Hughes, col. 13, lns. 40-56), but does not express any preference for this drying aid. Given the lack of any disclosure specifically directing one to select amodimethicone from the large number of drying aids, it appears that the Office's selection is entirely unsupported. Moreover, the Office has not answered (and cannot answer) the important question as to what is the teaching, suggestion, or motivation for selecting an amodimethicone from all of Hughes' drying aids? Absent a sufficient answer to this question, the Office's selection of amodimethicone from Hughes is evidently an arbitrary selection that can be only explained as improper hindsight reconstruction using Applicants' own disclosure. *See In re Dembiczak,* 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.").

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Even if there would have been motivation for picking amodimethicone out of Hughes' disclosure (though Applicants do not concede this point), there certainly would not have been any motivation for picking an amodimethicone having amine number of greater than or equal to 0.4 meq/g. Hughes, in fact, has not been cited for teaching or suggesting an amodimethicone having such an amine number. Applicants remind the Office that the presently claimed invention, as set forth more specifically in, for example, claim 1, includes not merely an aminated silicone but "at least one aminated silicone having an amine number of greater than or equal to 0.4 meq/g." The Office is directed to page 9, lines 7-9 of the present specification for a further explanation of the amine number.

Therefore, since the present rejection is based on arbitrary picking and choosing of drying aids according to Hughes, and since, even if such arbitrary picking and choosing led the skilled artisan to amodimethicone, the Office has not shown that the skilled artisan would necessarily have an aminated silicone falling within the scope of the claimed invention, the rejection is in error and should be withdrawn.

4. *THE OFFICE HAS CONFUSED THE PRINCIPLES OF INHERENCY WITH MOTIVATION TO SELECT A PARTICULAR PROPERTY*

In response to Applicants' previous showing that there would not have been any motivation for picking from Hughes an amodimethicone having amine number of greater than or equal to 0.4 meq/g, the Office has argued that "an amine number is an inherent property of a chemical compound.... [and therefore] there is no need to separately address motivation for substituting amine numbers." (Office Action, pg. 6, ln. 11-14 (emphasis added).) This argument is fallacious.

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While some given property may, in fact, be an inherent property of a chemical compound, not all chemical compounds will have the given property at specific value or range. For example, mass is an inherent property, but not all polymers have a mass of, for instance, greater than 20,000 units. Likewise, not all aminosiloxanes, including not all aminodimethicones, have an amine number of greater than or equal to 0.4 meq/g. In fact, the present specification expressly identifies several commercial amodimethicone products that do not have an amine number within this range. As shown on pages 22-23 of the present specification, Wacker's Finish WR 100 in an amodimethicone with an amine number of 0.15 meq/g, Wacker's Finish WR 1300 is an amodimethicone with an amine number of 0.3 meq/g, OSI's Silsoft TP 515 is an amodimethicone emulsion with an amine number of 0.058 meq/g, and Dow Corning's DC939 is an amodimethicone emulsion with an amine number of <0.1 meq/g.

Therefore, given the fact that the present rejection is based on a misapplication of the theory of inherency, the rejection is in error and should be withdrawn.

5. *THE OFFICE'S ADMISSION THAT IT HAS NOT "ADDRESS[ED A] MOTIVATION FOR SUBSTITUTING AMINE NUMBERS" IS DETERMINATIVE OF THE FAILURE TO ESTABLISH A PRIMA FACIE CASE OF OBVIOUSNESS*

The Office's argument that "an amine number is an inherent property of a chemical compound.... [and therefore] there is no need to separately address motivation for substituting amine numbers," (Office Action, pg. 6, ln. 11-14), demonstrates the Office's failure to even attempt to allege this necessary element of a prima facie case of obviousness, as required by *In re Rouffet* and *In re Lee*, *supra*.

For instance, much like the situation of a genus-species relationship, the selection of an aminated silicone having an amine number greater than or equal to 0.4

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meq/g requires the Office to show, among other things, a motivation for the particular selection. As directed in MPEP § 2144.08(II)(A)(4), "Office personnel should determine whether one of ordinary skill in the relevant art would have been motivated to make the claimed invention as a whole, i.e., to select the claimed species or subgenus from the disclosed prior art genus." *See also In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984) ("The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound.").

Accordingly, the Office's position that "there is no need to separately address motivation for substituting amine numbers," (Office Action, pg. 6, ln. 11-14 (emphasis added)), is legally erroneous. This error, especially when coupled with the Office's actual failure to separately address the required motivation, necessarily defeats the Office's alleged prima facie case of obviousness.

6. *THE REFERENCES ACTUALLY TEACH AWAY FROM THE PROPOSED MODIFICATION BECAUSE THE SILICONES ACCORDING TO SEBAG ARE USED FOR A DIFFERENT PURPOSE THAN THE ALKYLAMINO SUBSTITUTED SILICONES ACCORDING TO HUGHES*

The Office proposes substituting the silicones of Sebag with an aminodimethicone selected from Hughes. (Office Action, pg. 5.) However, since Hughes's amodimethicones and Sebag's silicones are disclosed for separate and independent functions, there would have been no motivation to make the proposed substitution.

Sebag teaches using silicones as conditioners. (Sebag, col. 1, ln. 25-28.) More specifically, Sebag discloses using silicones that are insoluble in the carrier to provide

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keratin substances with properties of softness, sheen, and disentangling. (Sebag, col. 2, lns. 50-55.)

In contrast, amodimethicones selected by the Office from Hughes have a distinct function. They are drying aids. (Hughes, col. 10, ln. 32 - col. 15, ln. 2.) Hughes addresses at great length the goal of decreasing the drying time for compositions comprising polysiloxane-grafted adhesive polymers and a volatile, water insoluble solvent. (Hughes, col. 1, ln. 61 - col. 2, ln. 55.) To this end, Hughes includes in the composition a drying aid, the presence of which "facilitates continued evaporation of volatile solvent that would otherwise be trapped beneath the surface of the film, thus providing an overall decrease in drying time." (Hughes, col. 3, ln. 30-34 (emphasis added).) The drying aids are not taught to have any utility in the absence of the volatile, water-insoluble solvent for the adhesive polymer.

When the Office attempts to justify the proposed substitution by alleging that "Hughes teaches his aminated silicones as additionally providing increased rate of drying" (Office Action at 5), the disclosure of Hughes is being effectively misrepresented. This allegation misrepresents Hughes by implying that the drying aids provide multiple functions in addition to drying. This is not the case. As shown above, Hughes' drying aids are taught to provide Hughes' volatile, water-insoluble solvent-based compositions with increased drying rates. The drying aids are not taught to provide the enhanced drying in addition to any other property, and are not disclosed to provide any conditioning properties, which are the function of Sebag's silicones.

Thus, there would have been absolutely no utility, desire, or motivation, based on the cited references, to add or substitute a drying aid according to Hughes into the

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water based compositions according to Sebag, which have not been shown to contain a volatile, water-insoluble solvent that needs to be evaporated. Moreover, while the compositions according to Hughes are applied and then evaporated (and thus depend on drying of the composition) the example compositions according to Sebag are all shampoos that are applied and washed away. There is no evidence of any utility for a drying aid according to Hughes in such a shampoo.

During the November 12, 2002, Examiner's Interview, the Office appeared to take the position that as long as two components are both cosmetic composition components, the Office need not show any motivation for the proposed substitution and that the proposed substitution is in no way improper given the different functions of the components. To the extent that this is the Office position, it amounts to ignoring the teachings of the references as a whole and treating them as virtual catalogs from which individual components can be arbitrarily selected and combined with those of another reference. However, "[v]irtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents... cannot be the law under the statute, § 103." *Pandait Corp. v. Dennison Mfg. Co.*, 1 USPQ 1593, 1630 (Fed. Cir. 1987) (footnotes omitted). Should the Office maintain the present rejection, in order to clarify the record for Appeal, it is expressly requested that the Office clarify its position on this point.

Therefore, since Hughes uses aminated silicones for a different purpose (drying aid) than Sebag uses silicones (provide softness, sheen, and disentangling), there would have been no motivation to make the proposed substitution.

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7. *THERE WOULD HAVE BEEN NO MOTIVATION TO SUBSTITUTE HUGHES'S ALKYAMINO SUBSTITUTED SILICONES FOR SEBAG'S SILICONES IN SEBAG'S SPECIFIC COMPOSITIONS.*

Sebag has not been cited for and does not provide any discussion related to an amphoteric/anionic surfactant ratio. This is irrefutable. At most, the Office has cited Sebag's Example 1 composition as having both types of surfactants. (Office Action dated March 13, 2002, pg. 6.) In order to establish a prima facie case of obviousness, the Office would have to at least point to a motivation to make the proposed substitution of Hughes' aminated siliconces for Sebag's silicones with respect to specific example compositions allegedly containing the claimed surfactant ratio.[4] The question is, for example, what is the motivation of record to modify the shampoo composition of Sebag, Example 1, which already functions as desired by Sebag? The answer is that there would have been no motivation to modify Sebag's already complete and successful composition.

Moreover, although the Office cites Sebag for disclosing "[p]olyorganosiloxanes containing substituted or unsubstituted amine groups," (Office Action dated March 13, 2002, pg. 6, lns. 15-16), the composition of Sebag Example 1 contains polydimethylsiloxane, which is unsubstituted with amine groups. (Sebag, col. 17, ln.

[4] The Office asserts that it is free to consider the entirety of Sebag, and is not limited to the examples. (Office Action, pg. 6.) However, it would constitute impermissible picking and choosing to arbitrarily select the relative amphoteric and anionic surfactant amounts from a particular example, ignore their context, and freely use the ratio of these amounts with any and all other disclosures in Sebag. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurre, Inc.*, 230 USPQ 416, 419-420 (Fed. Cir. 1986). While the principle of relying on a reference in its entirety is certainly true, the method in which this principle has been applied by the Office is arbitrary and capricious. It also betrays the Office's reliance on hindsight reasoning, since there is no basis or evidence that the Office has pointed to or can point to to justify selecting a particular ratio from an example and freely combining this ratio with other aspects of the reference.

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52.) Accordingly, assuming for the sake of argument only (though Applicants do not concede the point) that there is a motivation "to substitute the alkylamino substituted silicones of Hughes for the aminated silicones of Sebag et al." (Office Action dated March 13, 2002, pg. 7, lns. 15-20 (emphasis added)), the Office has not shown a basis for substituting the aminated amodimethicone of Hughes for the non-aminated polydimethylsiloxane of, for example, Sebag Example 1.

In the absence of the requisite motivation, a prima facie case of obviousness has not been established.

8. EVIDENCE OF NON-OBVIOUSNESS

Applicants in no way concede that the Office has established a prima facie case of obviousness. Hence, there is no duty to identify evidence of non-obviousness. MPEP § 2142. Nevertheless, Applicants direct the Office's attention to the comparative examples in the present specification that unequivocally demonstrate the unexpected properties of a composition comprising an amphoteric/anionic surfactant ratio within the claimed range and an aminated silicone having an amine number within the claimed range.

For instance, as shown in Example 1 at pages 20 and 21 of the present specification, two shampoo compositions differing in their amphoteric/anionic surfactant ratios have different transparencies. Specifically, comparative composition "B," which has an amphoteric/anionic surfactant ratio of 0.14 is not transparent. In contrast, composition "A," which has an amphoteric/anionic surfactant ratio of 0.33 is transparent. Further, hair shampooed with composition "A" more readily disentangles, and was softer and smoother than hair shampooed with composition "B."

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Additionally, with specific respect to the aminated silicone, Example 2 on pages 21-23 of the present specification directly compares eleven compositions, six of which have an aminated silicone with an amine number of less than 0.4 meq/g, and five of which have an aminated silicone with an amine number of greater than or equal to 0.4 meq/g. Consistently, the compositions with the lower amine numbers were not transparent and not stable, while those with the higher amine number were both transparent and stable.

Applicants submit that the Office has not identified any art that would represent a better or closer comparison for the claimed invention. Moreover, Applicants submit that there is no basis in the cited references or anywhere in the record from which one would expect these results.

II. U.S. Patent No. 6,162,424 to Decoster in view of Hughes and Natio

Claims 1-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,162,424 to Decoster (Decoster '424) in view of Hughes and Natio. (Office Action, pg. 6.) As with the rejection over Sebag in view of Hughes and Natio, the Office proposes that it would have been obvious to substitute the alkylamino substituted silicones of Hughes for the silicones of Decoster '424 for the reason that alkylamino substituted silicones of Hughes are taught to provide increased hold strength and decreased drying time. (Office Action dated March 13, 2002, pg. 9, ln. 1-6.) For at least the following reasons, Applicants respectfully disagree with and traverse the rejection. Reconsideration and withdrawal of the rejection are respectfully requested.

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1. *THE REFERENCE COMBINATION FAILS TO TEACH OR SUGGEST ALL THE CLAIMED ELEMENTS, INCLUDING THE AMPHOTERIC/ANIONIC SURFACTANT RATIO.*

According to the Office, Example 1 of Decoster '424 discloses sodium lauryl ether sulphate as an anionic surfactant and diallyldimethylammonium chloride homopolymer as an amphoteric surfactant. (Office Action, pg. 8, lns. 15-17.) As disclosed in Decoster '424, Example 1, composition B contains 15.5g of the cited anionic surfactant and 0.6g of the cited amphoteric surfactant. The ratio by weight of the amphoteric surfactant/anionic surfactant is 0.6/15.5 or 0.04:1. In contrast, as set forth more specifically in the claims, the presently claimed composition must have an amphoteric/anionic surfactant ratio of greater than or equal to 0.2:1. Accordingly, as the secondary references have not been cited for teaching or suggesting this element, a prima facie case of obviousness has not been established since the references, taken together, fail to teach or suggest all the claimed elements.

2. *IT IS IMPERMISSIBLE FOR THE OFFICE TO RELY ON ALLEGEDLY "ROUTINE OPTIMIZATION" WHEN A VARIABLE HAS NOT BEEN RECOGNIZED AS RESULT EFFECTIVE IN THE CITED REFERENCE.*

Regarding the presently claimed amphoteric/anionic surfactant ratio, the Office argues that "discovering the optimum or workable ranges involves only routine skill in the art." (Office Action, pg. 7.) However, according to the MPEP, "[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." MPEP § 2144.05 (emphasis added); *see also Samain*, *supra*. Thus, the Office's present assertion is wrong as a matter of law since there is no evidence that the ratio was

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recognized as a result effective variable. The Office's holding of obviousness based thereon should be withdrawn.

3. *THE OFFICE IS NOT FREE TO MAKE UNSUPPORTED SELECTIONS BASED ON HINDSIGHT RECONSTRUCTION OF APPLICANTS' OWN DISCLOSURE.*

The Office does not (and can not) dispute the fact that the Fluid DC 939 disclosed in Decoster '424 Example 1 does not have an amine number of greater than or equal to 0.4 meq/g. However, rather than conceding the failure to establish a prima facie case, the Office appears to argue that since elsewhere in Decoster '424 there is a disclosure of amodimethicone generally, it is free to arbitrarily select an aminodimethicone having an amine number of greater than or equal to 0.4 meq/g. (Office Action, pg. 7.) However, as discussed previously, the Office is not free to conduct such unsupported picking and choosing to select the portions of a reference that support its position and, at the same time, ignoring the portions that do not. *See In re Wesslau*, 147 USPQ 391, 393 (CCPA 1965) ("It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art".).

Moreover, the Office must provide evidence of a motivation for each particular modification or substitution. MPEP § 2144.01; *see also In re Rouffet* and *In re Lee*. In the present case, the Office has not even attempted to provide such motivation. Instead, the Offices eludes to "the admitted knowledge in the art." (Office Action, pg. 7.) However, this vague elusion, in absence of any findings of fact, has no basis in making a rejection. *See, e.g., In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002).

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4. THERE WOULD HAVE BEEN NO MOTIVATION TO SUBSTITUTE HUGHES' ALKYAMINO SUBSTITUTED SILICONES FOR THE SILICONES OF DECOSTER '424

Decoster '424 teaches silicones to provide softness and other properties (Decoster '424, col. 1, lines 31-26), while Hughes teaches alkylamino substituted compounds as drying agents, as discussed above. Given the different uses for the silicones of the two respective references, there would have been no motivation for the Office's proposed substitution and, hence, no prima facie case of obviousness has been made.

Reconsideration and withdrawal of the rejection are respectfully requested.

III. U.S. Patent No. 6,159,914 to Decoster in view of Natio

Claims 1 and 33 were rejected under 35 U.S.C § 103(a) as being unpatentable over U.S. Patent No. 6,159,914 (Decoster '914) in view of Natio. (Office Action, pg. 8.) Applicants respectfully disagree with and traverse the rejection. As discussed in detail in Applicants' Amendment filed June 13, 2002, Decoster '914 does not teach an aminated silicone having an amine number greater than or equal to 0.4 meq/g. Accordingly, since Natio has not been cited for and does not teach such an aminated silicone, the references, taken together, fail to teach or suggest all the elements of the presently claimed invention. Thus, the proposed combination fails to support a prima facie case of obviousness.

Reconsideration and withdrawal of the rejection are respectfully requested.

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CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Should the Office continue to dispute the patentability of any of the pending claims, in order to make the record clear for Appeal the Office is requested to clarify its position with respect to the above-identified deficiencies in the Office's argument.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: January 28, 2003

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